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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EASTMAN KODAK COMPANY

Appeal 2008-1276
Application 10/762,668
Technology Center 3700

Decided: July 23, 2008

Before JAMESON LEE, RICHARD TORCZON, and
MICHAEL P. TIERNEY, *Administrative Patent Judges*.

Filed by TORCZON, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Claims 1, 2, 4-6, and 8 are rejected as having been obvious under 35 U.S.C. § 103 (Ans. at 4). The appellant, Eastman Kodak Company (Eastman Kodak), seeks review under 35 U.S.C. § 134. We have jurisdiction under 35 U.S.C. § 6(b). We AFFIRM.

The examiner relies upon the following prior art in rejecting the claims (Ans. at 3):

Gutttag	US Patent 5,120,089	9 Jun. 1992
Martin	US Patent 5,601,683	11 Feb. 1997

The examiner uses the following patents as rebuttal evidence to support the examiner's position that Eastman Kodak's third indicium is inherent (Ans. at 3-5):

Denenberg, et al.	US Patent 5,673,338	30 Sept. 1997
Rhoads	US Patent 6,771,796B2	3 Aug. 2004

THE CLAIMS

Eastman Kodak's claimed invention relates to the printing and verification of limited edition stamps (Spec. at 1). Eastman Kodak argues claims 1, 2, 4-6 and 8 as a group (Br. at 3-11). Claims 2 and 4-6 depend on claim 1 (Br. at 13). Claims stand or fall together if they are not argued separately. 37 C.F.R. § 41.37(c)(1)(vii). We select claim 1 as broadly representative of the claims on appeal. Claim 1 is reproduced below from the Appeal Brief (Br. at 13):

A limited edition official postal stamp comprising:
a visible first indicia [sic] identifying said limited edition stamps as being a limited edition;
a second indicia [sic] not capable of being scanned and further not visible under normal conditions for confirming that said limited edition stamp is a valid limited edition stamp, said second indicia is made from an ink that can be seen when viewed under UV or infrared light; and
a third indicia [sic] for identifying a printer and/or a location where said limited edition stamp was printed.

Eastman Kodak contends that the references fail to disclose the claimed second indicium (Br. at 3-8). In addition, Eastman Kodak contends

that the cited prior art does not expressly or inherently teach a third indicium for identifying the printer that printed the stamp as recited in claims 1 and 8 (Br. at 8-11).

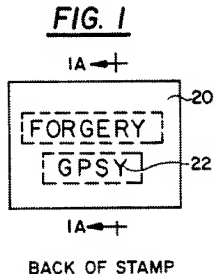
ISSUE

Did Eastman Kodak show the examiner erred in rejecting claims 1, 2, 4-6, and 8 as being directed to subject matter that would have been obvious in view of the cited prior art?

FINDINGS OF FACT

1. A postage stamp is a philatelic item (Gutttag, col. 2, ll. 33-42).
2. Gutttag relates to a method of protecting philatelic items against alterations and forgeries (Gutttag, col. 1, ll. 6-7).
3. Gutttag discloses that a visible mark of an expert, expert committee, or owner can be applied to a postage stamp (Gutttag, col. 2, ll. 43-47; "GPSY" in Gutttag FIG. 1, right).
4. Gutttag discloses that a second visible mark identifying the philatelic item as a forgery can be printed on the back of the philatelic item (Gutttag, col. 2, ll. 52-54; "FORGERY" in Gutttag FIG. 1, right).

5. Gutttag teaches that an expert or expert committee can individualize the marking on the stamp in ways other than by the position of the mark, for example, by serially numbering the copies of the stamp to distinguish each stamp (Gutttag, col. 4, ll. 3-12).



6. Martin discloses a fluorescence printing means that causes printed indicia to fluoresce under ultra-violet (UV) light (Martin, col. 3, ll. 56-60).

7. Rhoads teaches that a forensic tracer can memorialize the serial number of the machine that processed a banknote (Rhoads, col. 2, ll. 57-60).

8. Rhoads teaches that a forensic tracer is not normally inserted because of privacy concerns (Rhoads, col. 2, ll. 60-63).

9. Denenberg discloses that print documents have a unique microscopic anomalies created by random physical and statistical effects occurring at the time of printing, giving each object a unique fingerprint that is virtually or wholly impossible to reproduce (Denenberg, col. 3, ll. 49-59).

10. Eastman Kodak discloses that collectors like limited editions that are individually numbered (Spec. at 1).

11. According to Eastman Kodak, a difference between Eastman Kodak's claimed invention and Gutttag's teachings is that Gutttag prints a second visible mark on the stamp, while Eastman Kodak's claimed invention prints the second indicium not visible under normal viewing conditions (Br. at 4).

12. According to Eastman Kodak, another difference between Eastman Kodak's claimed invention and the Gutttag patent is that Gutttag does not print a third indicium for identifying the printer or location where the limited edition stamp was printed (Br. at 8).

13. According to Eastman Kodak, a person of ordinary skill in the art would have known that an artist can create an etching and then print a limited number of copies that are individually numbered (Spec. at 1).

14. A person of ordinary skill in the in the philatelic art would have known that stamps can be altered and forged (Gutttag, col. 1, ll. 11-13).

15. A person of ordinary skill in the philatelic art would have known that experts who specialize in determining the authenticity print their names or other marks showing their identities on philatelic items (Gutttag, col. 1, ll. 13-27).

16. A person of ordinary skill in the art would have known that various methods have been developed to deter photocopying of originals including special inks, special patterns, or graduations in the thickness of the printed image, or some combination of these methods (Martin, col. 1, ll. 17-23).

17. A person of ordinary skill in the art would have known that UV fluorescent inks that are invisible in daylight and in normal artificial light can be used to mark valuable documents to reduce the possibility of forgery (Martin, col. 2, ll. 36-41)

18. A person of ordinary skill in the art would have known that each printed document has unique characteristics on a microscopic level because of differences in the ink's distribution on the texture of the paper (Denenberg, col. 1, ll. 47-54).

19. Eastman Kodak has not directed us to any evidence of secondary factors.

PRINCIPLES OF LAW

Pending claims must be interpreted as broadly as their terms reasonably allow. *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989). An applicant seeking a narrower construction must either show why the broader

construction is unreasonable or amend the claim to state expressly the scope intended. *In re Morris*, 127 F.3d 1048, 1057 (Fed. Cir. 1997).

In analyzing obviousness, the scope and content of the prior art must be determined, the difference between the prior art and the claim ascertained, and the ordinary level of skill in the art resolved. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17 (1966). The combination of familiar elements according to known methods is likely to be obvious when it does not more than yield predictable results. *KSR Int'l Co.*, 127 S.Ct. 1727, 1740 (2007). Non-obviousness cannot be established by attacking references individually when the rejection is based upon the teachings of a combination of references.” *In re Merck & Co. Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). A teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. *In re Kahn*, 441 F.3d 977, 987-88 (Fed. Cir. 2006).

Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). After the examiner establishes a basis for inherency, the burden shifts to the appellant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. *In re King*, 801 F.2d 1324, 1327 (Fed. Cir. 1986). The United State Patent and Trademark Office (PTO) is not equipped to perform testing. *Id.* at 1327.

ANALYSIS

First, Eastman Kodak states that the examiner added new references in the examiner's answer. Eastman Kodak argues that the examiner should

have entered a new ground of rejection that includes the Denenberg and Rhoads references (Br. at 3).¹ The examiner explains that the grounds for rejection remain the same. Claims 1, 2, 4-6, and 8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gutttag in view of Martin. The examiner states that the Denenberg and Rhoads references are cited as rebuttal evidence to support the examiner's position of inherency that each printer inherently prints the third indicium that can be used to identify the printer that printed the stamp (Ans. at 4-5).

We shall not use the Rhoads reference. The forensic tracer taught in Rhoads to identify the printer may or may not be implanted into the document because of privacy concerns. Inherency requires that forensic tracers necessarily be implanted in each document.(Findings 7-8). Therefore, Rhoads's forensic tracer can not be used to show inherency of a third indicium to identify the printer.

Denenberg teaches that each printed document has a unique microscopic anomalies created by the random physical and statistical effects that occur when printing (Finding 7). These microscopic characteristics are necessarily present in each printed document (Finding 16). Hence, we continue our analysis using only the Denenberg reference as rebuttal

¹ If there was indeed a procedural error, Eastman Kodak's remedy must come by way of a petition. MPEP § 1002.02(c). Eastman Kodak has not identified any basis for the Board to order such relief on its own authority. Hence, we shall proceed with the appeal and apply these references as evidence of inherency to the extent they are consistent with this purpose.

evidence that each printer has a unique fingerprint that can be used to identify the printer that printed the stamp.

Second, Eastman Kodak argues that the Gutttag reference fails to disclose a second indicium that is "not capable of being scanned and further not visible under normal conditions ...made from an ink that can be seen when viewed under UV or infrared light" as recited in claims 1 and 8 (Br. at 4). Gutttag discloses a second visible mark that identifies the philatelic item as either a forgery or a genuine postage stamp (Finding 4). The examiner combines Gutttag's second visible mark with Martin's use of UV inks (Ans. at 6). A person of ordinary skill in the philatelic art would have known that forgery is a problem in stamp collecting (Finding 14). Experts, who specialize in determining the authenticity of stamps, print their name or other marks on genuine postage stamps (Finding 15). A person of ordinary skill in the art would have known that UV inks can be used to print a second indicium that would make the second indicium invisible under normal viewing conditions (Finding 16). Since forgery is a problem in stamp collecting, the examiner's rationale that a person of ordinary skill in the art would have been motivated to use UV inks to print a second indicium is reasonable (Findings 6 and 17). Eastman Kodak is combining known elements in the prior art to obtain a predictable result (Findings 4 and 7). Eastman Kodak has not shown reversible error.

Third, Eastman Kodak argues that the Gutttag reference does not disclose a second indicium "for confirming that said limited edition stamp is a valid limited edition stamp" (Br. at 4). We take the broadest reasonable interpretation of the contested limitation in view of the specification. Eastman Kodak has not pointed us to any specific definition of indicia in its

specification for confirming that the stamp is a valid limited edition postage stamp. Eastman Kodak has not argued a specific definition in its brief (Br. at 3-8).

We construe indicia that confirm the limited edition official postage stamp is a valid stamp to include marks put on the stamp by an expert or marks indicating that the stamp is a genuine stamp or a forgery stamp (Finding 5). A person of ordinary skill in the art would have known that one way to confirm that the stamp is a limited edition is to use a series of individual numbers printed on each copy of the stamp (Findings 5, 10, and 13). We find that Gutttag discloses a mark that satisfies the claim limitation to confirm whether a stamp is a valid limited edition postage stamp (Findings 1-5). Eastman Kodak has not shown reversible error.

Fourth, Eastman Kodak argues that Martin reference does not expressly or inherently disclose the printing of a second indicium in the manner recited in claims 1 and 8 (Br. at 5). Eastman Kodak attacks the references individually when the examiner uses the combination of Gutttag and Martin to reject the claims (Ans. at 4). The examiner's rationale, that one of ordinary skill in the art would have known to combine Martin's UV ink with Gutttag's second indicium, is reasonable because UV inks have been used to reduce forgery of valuable documents (Finding 16). Forgery is a known problem in stamp collecting (Finding 14). Eastman Kodak has not shown reversible error.

Fifth, Eastman Kodak argues that the Denenberg reference does not disclose, expressly or inherently, the printing of a second indicium in the manner recited in claims 1 and 8 (Br. at 6). The examiner uses the combination of Gutttag in view of Martin to reject the claims (Ans. at 4).

Eastman Kodak's argument is not persuasive because the Denenberg reference is being used by the examiner as rebuttal evidence that the third indicium is inherently disclosed (Ans. at 3-4).

Sixth, Eastman Kodak makes four separate arguments that the Gutttag, Martin, Denenberg and Rhoads patents do not disclose a third indicium for identifying a printer as recited in claims 1 and 8 (Br. at 8-10). The examiner states that the third indicium is inherent because of microscopic irregularities in the printing of a stamp. According to the examiner, these irregularities are inherently the third indicia. Gutttag teaches printing a second indicium on a stamp (Finding 4). The examiner urges that the third indicium is inherent when the printer prints the second indicium. The examiner's rationale is that each printer has a unique fingerprint that can be used to identify the printer (Ans. at 5). The examiner uses the Denenberg reference as rebuttal evidence to support his finding that the third indicium is necessarily present (Ans. at 4). Eastman Kodak bears the burden of showing that the relied upon inherent characteristics are not in the Gutttag reference. Eastman Kodak has not met this burden. The examiner is not equipped to prepare a sample according to Gutttag and then perform microscopic testing to see if it matches Denenberg's prediction. We find the examiner's rationale is reasonable because a person of ordinary skill in the art would have expected that each printed document has unique characteristics on a microscopic level (Finding 18).

Finally, we take the broadest reasonable interpretation of the third indicium for identifying a printer or location where the limited edition stamp was printed. Eastman Kodak has not pointed us to any specific definition of indicium in its specification for identifying the printer or location where the

limited edition stamp was printed. Eastman Kodak has not argued a specific definition in its brief (Br. at 8-11). Eastman Kodak is responsible for drafting the claim to include only what it intends to include. We construe the meaning of indicium for identifying the printer where the limited edition stamp was printed to include microscopic anomalies occurring at the time of printing. These anomalies give each printed stamp a unique fingerprint that can be used to identify the printer that printed the stamp (Finding 9). We find that Guttag teaches printing a second indicium on a stamp. The examiner's rationale is that by printing a second indicium on the stamp the third indicium is inherent. We find that each printed document has a unique fingerprint that is necessarily present that satisfies the claim limitation to confirm the printer that printed a limited edition stamp (Findings 2-5 and 18). Eastman Kodak cites no evidence that the third indium is not present in each document that can be used to identify the printer. Eastman Kodak has not shown reversible error.

CONCLUSION

Eastman Kodak has failed to show that the examiner erred in rejecting the claims over the prior art. Consequently, the rejection of all the pending claims under 35 U.S.C. § 103(a) is —

AFFIRMED

Appeal 2008-1276
Application 10/762,668

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